

**REMARKS / ARGUMENTS**

**I. General Remarks and Disposition of the Claims.**

Claims 1, 5-12, 14-30 34-40, and 87-113 are pending in this application. Claims 1, 30, 87 and 90 are currently amended. In addition, claims 16 and 102 have been cancelled.

Applicants respectfully request reconsideration in view of the remarks contained herein. Applicants thank the Examiner for his careful consideration of this application.

**II. Request to Withdraw Premature Finality of First Office Action**

In response to the RCE filed on May 23, 2006, Examiner designated the first office action as final and wrote as follows:

This is an RCE of applicant's earlier Application No. 10/698,293. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See MPEP § 706.07(b).

(*Final Office Action* at 8.) Applicants respectfully submit that the designation of this first office action as final is premature and improper, and therefore request that Examiner withdraw the finality of this office action.

A first action final is proper in the following circumstances:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

See MANUAL OF PATENT EXAMINING PROCEDURE § 706.07(b) (8th ed., rev. 3 2004). In the instant case, the claims presented in the RCE filed on May 23, 2006 would not have been properly finally rejected on the grounds and art of record if they had been entered in the earlier application. Thus, a first action final is improper and premature.

More specifically, Applicants amended independent claims 1, 30, 90 to include the limitation that the dispersant composition further comprises a defoamer. In rejecting Applicants' claims, the Examiner cited seven new references not previously of record. (*See Notice of References Cited*, August 18, 2006) Accordingly, because the claims would not have been properly rejected on the art of record, Applicants respectfully request withdrawal of the finality of the first action final in accordance with M.P.E.P. § 706.07(b).

### **III. Remarks Regarding the New Matter—Objection to the Specification**

Applicants' amendments to paragraphs 18, 19, 20, and 21 presented in their November 14, 2005 Response were objected to as "a new matter deletion." (*Final Office Action* at 2.) In this response, Applicants have amended the language in the specification, and therefore, respectfully request the withdrawal of this objection.

### **IV. Remarks Regarding the New Matter—Claims**

Claims 87-113 stand rejected under 35 U.S.C. § 112, ¶ 1 and § 132 "as the specification as originally filed does not provide support for the invention as now claimed." (*Final Office Action* at 2.) The Examiner previously stated in an Advisory Action that "[t]he rejection over claims 87-113 has been withdrawn as a result of applicants showing of location of support for the newly added claims." (*Advisory Action* at 2.) However, in the final subsequent office action, the Examiner stated "Applicants still have not provided the location of original support for these newly added claims and this new matter rejection remains." (*Final Office Action* at 2.) Applicants respectfully assert that they have shown that claims 87-113 are supported by Applicants' original disclosure, and accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, ¶ 1 and § 132 rejection as to claims 87-113.

### **V. Remarks Regarding the 35 U.S.C. § 112, Second Paragraph Rejection**

Claims 1, 5-12, 14-30, 34-40, and 87-113 stand rejected under 35 U.S.C. § 112, ¶ 2, as failing to set forth the subject matter which Applicants regard as their invention because the term "desired" in claims 1 and 87 and the term "low density cement" in claim 24 and 109 are indefinite. (*Final Office Action* at 2-3.)

At the outset, Applicants request withdrawal of the 35 U.S.C. § 112, ¶ 2 rejection for claims 1, 5-12, 14-23, 25-30, 34-40, 87-108, and 110-113 because these claims do not include, nor do these claims depend from a claim that includes, the terms "desired" or "low." Applicants previously amended claims 1 and 87 to no longer include the term "desired" in

accordance with the Examiner's preference. The term "low density cement" is found in claims 24 and 109.

With respect to the term "low," the Examiner states that "[t]he term 'low' is a relative and indefinite term and applicants have not defined what they mean by 'low' density cement by showing a numerical means so it is clear for the record." (*Final Office Action* at 3.) Although Applicants believe that the term "low" is sufficiently definite, Applicants will state for the record that one of ordinary skill in the art would understand the term "low density" to include those cement compositions with a density of 12.5 lb/gallon or less.

Accordingly, Applicants submit that claims 1, 5-12, 14-30, 34-40, and 87-113 satisfy 35 U.S.C. § 112, ¶ 2 and therefore, request withdrawal of the 35 U.S.C. § 112, ¶ 2 rejection.

#### **VI. Remarks Regarding the Obviousness Rejections**

Claims 1, 5-12, 14-30, 34-40, and 87-113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sugama, Gay, Neely*, or *Etherton* alone or in view of *Chatterji, Bour, Cattnach, Gopalkrishnan*, or *DiLullo Arias*. (*Final Office Action* at 3, 5-7.) To form a basis for a § 103(a) rejection, the suggested combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). Applicants respectfully assert that the combination of references cannot obviate these claims because that combination does not teach all elements of the claims.

In particular, none of the cited references teach or suggest the recitation of a "dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer, wherein the defoamer is present in an amount sufficient to prevent foaming of the dispersant composition." However, the Examiner states that:

The applicants now amend their claim to include the defoamer (an optional ingredient according to their own specification (see paragraph [0023] on p. 7). Nevertheless, the added use of a defoamer in a well cement composition would is [*sic*] notoriously known in the art and is routinely used as an obvious design choice for one of ordinary skill in the art. Should applicants seasonably challenge this assertion, the examiner respectfully provides the following references below which teach that the use of a defoamer in well cementing (and other cementing applications) is notoriously known in the art . . .

(*Final Office Action* at 5). Applicants disagree. *Sugama*, *Gay*, and *Etherton* are directed to foamed compositions. Thus, adding a defoamer in “an amount sufficient to prevent foaming” would be contrary to their teachings and objectives. Similarly, Applicants submit that *Neely* does not teach using a hydrolyzed protein in combination with a defoamer and a surfactant as a dispersant composition in methods of cementing in a subterranean formation as recited in independent claims 1, 30 and 90. *Neely* does not teach cement compositions but instead teaches “coating compositions” that may comprise surfactants, hydrolyzed proteins, and a defoamer only when they are used to coat stainless steel (*Nelly*, col. 6, ll. 3-9, col. 7, ll. 11-16). Thus, Applicants respectfully assert that independent claims 1, 30 and 90 and its dependents are not obviated by the cited references.

Thus, because the combination of the references do not teach or suggest all elements of independent claims 1, 30 and 90, those references cannot obviate claims 1, 30 and 90. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 5-12, 14-29, 34-40, 87-89, and 91-113 depend, directly or indirectly, from claims 1, 30 or 90, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicant respectfully requests the withdrawal of these rejections.

## **VII. Remarks Regarding the Obviousness-Type Double Patenting Rejection**

Claims 1, 5-12, 14-30, 34-40, and 87-113 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 52 of *Reddy I* (U.S. Pat. No. 6,454,004) and *Reddy II* (U.S. Pat. No. 6,793,730) alone or in view of *Cattanach* (U.S. Pat. No. 3,615,784 or FR 1550231). (*Final Office Action* at 3.)

The standard for a double patenting rejection is whether the claim in the application is an obvious variation of an invention claimed in the patent. MPEP § 804(B)(1). Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly-owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. This double patenting analysis is confined to a comparison to the claims in the patent, and not to use of the disclosure of the patent as prior art. *See* MPEP § 804(III).

The claims of the present invention include, among others, the following limitation, a “dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer, wherein the defoamer is present in an amount sufficient to prevent foaming of the dispersant composition.” Applicants respectfully assert that the claims of *Reddy I* and *Reddy II*, alone or in view of *Cattanach*, have not been shown to refer to a dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer, wherein the defoamer is present in an amount sufficient to prevent foaming of the dispersant composition. The Examiner simply has not shown any aspect of the invention in *Reddy I* and *Reddy II*, alone or in view of *Cattanach*, to include these limitations. Therefore, the Examiner has not shown that the claims of the present invention fail to be patentably distinct from the claims of *Reddy I* and *Reddy II*, alone or in view of *Cattanach*. Because Applicants’ claims contain limitations not claimed in *Reddy I* and *Reddy II*, alone or in view of *Cattanach*, Applicants respectfully submit that the claims of the present invention are patentably distinct from the claims of *Reddy I* and *Reddy II*, alone or in view of *Cattanach*. Applicants respectfully requests withdrawal of the obviousness-type double patenting rejection as to claims 1, 5-12, 14-30, 34-40, and 87-113, and the timely issuance of a Notice of Allowance for these claims.

#### **IV. No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinction discussed by Applicant is sufficient to overcome the anticipation and obviousness rejections.

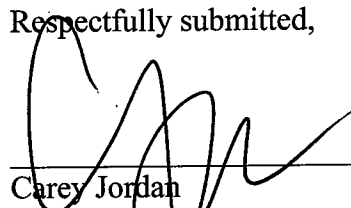
#### **SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this

application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicant believes that no fees are due in association with this filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicant respectfully requests that the Commissioner accept this as a petition therefor, and direct that any additional fees be charged to Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.0341.

Respectfully submitted,



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